

Japanese reference in view of Newman et al. (U.S. Pat. No. 4,542,311). The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over the Japanese reference in view of Bader (U.S. Pat. No. 5,763,965).

**Rejection of claims 1-3 and 5 under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-3 and 5 under 35 U.S.C. § 102(b) as anticipated by the Japanese reference. Applicants respectfully traverse the rejection for the following reasons.

To establish anticipation of claims 1-3 and 5 under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in claims 1-3 and 5 is either explicitly disclosed or “necessarily present” in the Japanese reference. See M.P.E.P. § 2131 (7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). Each of the Examiner’s factual conclusions must be supported by “substantial evidence” in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, (Fed. Cir 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation “less the ‘haze of so-called expertise’ acquire insulation from accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. § 102(b).

The Examiner, however, simply stated that “claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 11-206100.” See Office Action, page 2. Thus, the Examiner has failed to satisfy his burden of demonstrating how the Japanese reference can anticipate each and every one of the limitations

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present in claims 1-3 and 5, as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Moreover, claims 1-3 and 5 are not anticipated by the Japanese reference. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See M.P.E.P. § 2131 (8<sup>th</sup> Ed., Aug. 2001), p. 2100-69. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* Finally, "[t]he elements must be arranged as required by the claim." See *id.*

Claim 1 recites a linear motor drive apparatus comprising a fixed element, which has a guide mechanism, a movable element, which is guided by the guide mechanism and which can move along a prescribed reference plane, parallel rows of first magnets, which are mounted to the fixed element, and which are arrayed in parallel at both sides of the reference plane, and parallel rows of second magnets, which are mounted to the movable element, and which are arrayed in parallel at both sides of the reference plane, wherein the parallel rows of first magnets are plane-symmetry with respect to the reference plane, and the movable element has, at a part thereof crossing the reference plane, a steel plate parallel to the reference plane, the steel plate having a narrowing configuration.

The Japanese reference does not disclose at least parallel rows of second magnets, which are mounted to the movable element, and which are arrayed in parallel at both sides of the reference plane as recited in claim 1. In the Japanese reference, movable element 10 includes layered magnetic steel plates 13 and layered magnetic

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steel plates 13 are not arrayed in parallel at both sides of a reference plane. See Abstract and FIG. 1. Since the Japanese reference fails to teach each and every one of the elements in the combination of claim 1, Applicants respectfully submit that the Japanese reference does not anticipate claim 1 under 35 U.S.C. § 102(b).

Claims 2, 3, and 5 depend on claim 1. For at least the reasons given above with respect to claim 1, Applicants respectfully submit that the Japanese reference does not anticipate claims 2, 3, and 5 under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

**Statement of common ownership**

The Examiner advised Applicants of "the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made." Applicants submit that the subject matter of the pending claims was commonly owned both at the time any inventions covered therein were made and at the present time.

**Rejection of claims 4 and 6 under 35 U.S.C. § 103(a)**

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as unpatentable over the Japanese reference in view of Newman. The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over the Japanese reference in view of Bader.

Applicants respectfully traverse the rejection for the following reasons.

"Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent

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claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim." M.P.E.P. § 608.01(n)(III), page 600-77. Claims 4 and 6 are dependent on claim 1. As discussed above, claim 1 is patentable over the Japanese reference. Neither Newman nor Bader cures the deficiency of the Japanese reference. For example, assuming Newman and Bader are arguably combinable with the Japanese reference, neither Newman nor Bader teaches or suggests parallel rows of second magnets, which are mounted to the movable element, and which are arrayed in parallel at both sides of the reference plane as recited in claim 1. Therefore, claims 4 and 6 are allowable at least for the reasons provided above with respect to claim 1 and also by virtue of their dependency on claim 1. Reconsideration and reexamination of claims 4 and 6 are requested.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that each and every one of claims 1-6 defines patentable subject matter, and that the application is in condition for allowance. Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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